

ARGUMENTS

Rejection of Claims on Art Grounds in the 11/17/2004 Office Action, and
Traversal Thereof

In the 11/17/2004 Office Action, claims 1-5 and 11-15 were rejected under 35
U.S.C. 103(a) as being unpatentable over US Patent No. 5,950,214 issued to Rivette et al.
(hereinafter Rivette) in view of Pub. No. US 2002/0116363 A1 of Grainger.

Office Action, Item #4:

Rejections of claims 1-5 and 11-15 are based on § 103(a) as being unpatentable over
Rivette et al., U.S. Patent No. 5,950,214, for *System, Method, And Computer Program
Product For Accessing A Note Database Having Subnote Information For The Purpose
Of Manipulating Subnotes Linked To Portions Of Documents*, in view of Grainger, Pub.
No. 20020116363, for *Method Of Deleting Unnecessary Information From A Database*.

The Present Invention Is Not Obvious Over The Cited References

A claimed invention may be found to have been obvious "if the differences
between the subject matter sought to be patented and the prior art are such that the subject
matter as a whole would have been obvious at the time the invention was made to a
person having ordinary skill in the art to which said subject matter pertains." 35 U.S.C. §
103(a). Moreover, the Federal Circuit has ruled on numerous occasions that a holding of
"obviousness" requires some motivation, suggestion or teaching within the cited
references that would lead one skilled in the art to modify the cited reference or
references as claimed by applicant. See, for example, *In re Kotzab*, 217 F3d 1365, 55
USPQ2d 1313 (Fed Cir. 2000):

"Most if not all inventions arise from a combination of old elements. See *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made

by the applicant. See *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. See *B.F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996)."

The cited references, in particular the main patent references Rivette and Grainger, describe electronic document display, comparison, and text generation. The claims of the present application also describe a electronic display of patent-related information. The invention described by Rivette pertains to extracting, synchronizing, displaying, navigating and manipulating text and image documents simultaneously in electronic form. On the other hand, the Grainger patent discloses an invention for storing parts of a patent application for use in generating the text of a patent application. The present invention also discloses a software tool. However, the software tool of the present invention as specifically claimed is novel and non-obvious over the cited references.

The Applicant respectfully reasserts that the Examiner's position on combining the references is only possible through hindsight of the present invention, as there is no motivation for combining the cited references. None of the cited prior art applied or not applied, disclose, teach or suggest graphical display and automatic electronic generation of the diagrams based upon components of an invention and/or a patent. The present invention is not merely providing for electronic document comparison, and is not merely providing for patent text generation, as in the case of the prior art cited by the examiner; rather, the present invention provides for automatically generating a viewable diagrammatic representation of components of technology or a patent application, and their hierarchical relationship. Therefore, neither Rivette nor Grainger, or combination

with any other cited references teach or suggest the above as called for in the independent claims of the present application. Thus, the independent claims along with their dependents cannot be properly held to be obvious over the cited references.

By way of more detailed information, notably, **Rivette** is not in the same field as the present invention. Rivette's invention involves extracting, synchronizing, displaying, navigating and manipulating text and image documents simultaneously in electronic form. As an example, this invention shows how it could be used to help analyze US patents by allowing a person to see both the images and text concurrently. Rivette focuses on analyzing that which is already existing, whereas the present invention provides for the analysis and generation of new inventions and patent applications using a fabricated or newly created digrammatic representation of the components of the invention.

Also, *Rivette does not automatically generate a diagram of components of technology or a patent application,* and the automatic features of his invention are severely limited. Rivette discloses "the automatic pagination of the text and image files provides an equivalence relationship, and a final Equivalent File is obtained through *human intervention* to correct any inaccuracies still remaining after the automatic process has been completed." *The fact that Rivette requires "human intervention" to generate a document is different from the way the present invention can automatically generate a diagram.*

Regarding **Grainger**, it essentially accomplishes the same tasks as the prior art discussed in the Glasgow patent application. There, Petruzzi, US Pat. No. 6,049,811 was cited as

prior art that was lacking in capabilities. From the Glasgow application, the following quote may be considered:

"However, this computer-based type of prior art merely serves to prompt the user for information to be entered into a patent application and automatically draft a patent application therefrom, without providing any sort of outline or preview of the patent application substance so that editing may be done in an early stage of patent drafting, saving time and avoiding inconsistencies within the patent that is eventually drafted. Furthermore, there is little flexibility of form or format within the patent application being generated with computer assistance; the user does not have an opportunity to define relationships between and among subcomponents that may have a significant effect upon patentability as well as the user's understanding of the invention that is claimed for the purposes of enforcement or explaining it to others."

The remainder of the Grainger invention appears to revolve merely around storing parts of a patent application for use in generating a patent application. Generally, it relates to a computer-implemented method of managing documents related to a patent application.

The two independent claims and substantive arguments are as follows:

I. Claim 1 (first independent claim)

A. The amended relevant language from Glasgow is as follows:

- i. "... and software installed and capable of running on the at least one computer for automatically generating a **diagrammatic** representation of an invention, wherein the diagrammatic representation includes a **hierarchical** component categorization of the technical components of the invention based upon the user inputted information and outputting a **viewable diagram** of that categorization and for **automatically** generating a document for filing as a **patent application**, including specification and claims, based upon the user inputted information and additional text-based detailed information that is organized consistent with the diagram;
..."

B. Considering amended claims language and the emphasized terms above the present invention is distinguishable from the prior art cited. Neither Rivette and Grainger do, teach, suggest, or motivate the combination to do these things. Respectfully speaking, the examiner makes a leap of faith and/or rejection based on hindsight by stating the following:

i. *"Revette [sic] does not explicitly teach automatically generating a hierarchical component categorization based upon the user-inputted information and outputting a viewable diagram of that categorization for automatically generating a document for filing as a patent application. However, Grainger teaches a patent application is automatically created [sic]. Therefore, it would have been obvious . . . to combine [Rivette with Grainger]."*

ii. *It does not follow that combining Rivette and Grainger would yield a viewable, hierarchical diagram that could automatically generate a document for filing as a patent application, and there is no motivation in either reference to make the present invention as claimed. Therefore, the examiner's rejection was made improperly in hindsight of the present invention.*

C. The addition of the **diagrammatic** clause in this amendment to Glasgow merely clarifies and assists in the explanation of how Glasgow is sufficiently non-obvious over Rivette in view of Grainger.

D. The following are key quotes from Glasgow that further substantiates the above argument. Terms representing important distinctions over the prior art are emphasized.

i. *The software of the present invention is designed and configured to provide a graphical interface for **diagramming the structure of intellectual property in a patent application or for assessment of technology or issued patents and for automatically creating text-based description linked to components in the diagram, indicating their hierarchical relationship, and integrating those descriptions into a coherent specification and claims of a patent application.***

ii. *The software of the system according to the present invention is designed and established to aid in **diagramming intellectual***

2. *This linked tree structure enables elements to be easily moved, sorted, and graphically rendered with a minimum of processing delay and memory usage.*

II. Claim 11 (second independent claim)

- A. This claim is a method claim developed from Claim 1. The above arguments should be applicable to this claim as well.

Claims 6 -10 were rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,950,214 issued to Rivette in view of Pub. No. US 2002/0116363 A1 of Grainger, and further in view of Pub. No. 2002/0073165 of McNulty et al. (hereinafter McNulty). As the independent claims have been amended and argued to be distinguishable from Rivette, the claims 6-10, under the same arguments are now asserted to be allowable.

Applicant asserts that the prior art reference cited by the examiner does not anticipate the claims. Furthermore, the number of claims has been increased in order to more distinctly state the scope of the present invention. The above rejections of the claims 1- 15 on the stated art grounds are traversed, and consideration of the patentability of the claims 1- 19, now amended or added, is requested, in light of the foregoing amendments and the foregoing remarks. The newly added claims 16-19 do not introduce new matter and include all of the limitations of the independent claim 1, namely *automatically generating a diagram of components of technology or a patent application and their hierarchical relationship.*

CONCLUSION

In view of the foregoing, claims 1- 19, now amended or added, constituting the claims pending in the application, are submitted to be fully patentable and in allowable

condition to address and overcome the rejections. If any issues remain outstanding, incident to the allowance of the application, Examiner Ly is respectfully requested to contact the undersigned attorney at (919) 664-8222 or via email at jinang@trianglepatents.com to discuss the resolution of such issues, in order that prosecution of the application may be concluded favorably to the applicant, consistent with the applicant's making of a substantial advance in the art and particularly pointing out and distinctly claiming the subject matter that the applicant regards as the invention.

This Office Action response is submitted via facsimile to the USPTO Central Official Fax number 703-872-9306 on March 16, 2005, with a request for extension of time for one month, and payment of the fees therefor.

Respectfully submitted,



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